

REMARKS

A reconsideration is respectfully requested of Claims 1-30, wherein Claims 5, 11, 12, 13, 23, 24-26 and 29-30 have been amended.

As an initial matter, the drawings stand objected to for the reasons set forth in paragraph 1 of the Official Action. As a result, Applicant is submitting new drawings addressing the issue in the draftsman report and changing number 63 in Figure 3 to 62. Accordingly, withdrawal of the drawing objections is respectfully requested.

Paragraph 2 of the Official Action rejects the application under 35 U.S.C. §112, first paragraph. However, the Examiner has not rejected any claims in connection therewith. Nevertheless, Applicant has amended the specification to eliminate the objectionable terms used in the specification. However, with regard to the Examiner's position that number 2A and number 2B are not recited in the specification, Applicant respectfully disagrees and directs the Examiner's attention to paragraphs 38 and 39 of the application. In addition, with regard to the objection "brief description to Figure 1", Applicant does not understand what the Examiner is referring to. Accordingly, Applicant requests clarification with regard to this matter. With regard to the remaining terms recited in the specification, Applicant submits that these terms are appropriately used. Accordingly, withdrawal of the objections to the specification is respectfully requested.

Paragraph 3 of the Official Action indicates that the drawings stand objected to under 37 C.F.R. §1.18(a). In particular, the Examiner alleges that the features of Claims 14-16 are not shown in the drawings. However, Applicant submits that the features of Claim 14 are shown in Figure 1, and the features of Claims 15 and 16 are

shown in Figure 3. Accordingly, withdrawal of the drawing objections is respectfully requested.

Claims 5, 7, 11, 12, 13, 23, 24, 25, 26, 29 and 30 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As a result, these claims have been amended to remove the indefiniteness by the Examiner. Accordingly, withdrawal of objections based on 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 1-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,406,570 to *Duncan et al.* in view of German Publication 4343631, U.S. Patent No. 5,507,613 to *Tokiwa*, U.S. Patent No. 3,883,008 to *Castaldi*, U.S. Patent No. 5,328,316 to *Hoffmann* and German Publication 19743793.

The disclosed embodiment of the present invention pertains to a shelf storage facility. A plurality of shelf bays are provided where each shelf bay presents a shelf with an upper side providing for guiding means fixed to the shelf, whereof each is disposed in a shelf bay and is configured as a guiding channel extending in the longitudinal direction of the shelf. A plurality of products support are provided whereof one at a time is associated with a shelf bay, which support is provided with guiding means fixed to the product support, which means equal each other and are complimentary to said guiding means fixed to the shelf, as well as a supporting surface for products to be stored. A storage and retrieval device is provided and designed for being moved in front of each of the shelf bays. The product support is supported for displacement in the longitudinal direction relative the guiding channel

of the respective shelf. The product support comprises a receiving channel extending in a longitudinal direction and open in the upward direction, whose at least one face side has an open configuration. The storage and retrieval device provides for an actuating finger adapted to be engaged in the product support and to be displaced in the longitudinal direction, as well as at least one retaining finger that is pivotable into the clearance of the receiving channel open in the upward direction. These features are defined in independent claim 1.

With reference to Figures 6-11, the main objective of the present invention is illustrated. As stated in the application, it is an object of the facility to separate one of several products having different shapes and sizes stored in a row along a product support 42 which is supported by shelf bay 35. With reference to Figure 6, the product support 42 is on a shelved bay 35 having three boxes 48A, 48B and 48C. The aim of the invention is to separate, for example, the single box 48C from the product support. In a first step, the product support 42 is pulled by an actuating finger 74 engaging in a recess 46 inside the product support. The actuating finger 74 is displaced in a longitudinal direction so that the whole product support 42 will be pulled onto the storage and retrieval device as shown in Figure 7. In Figure 8, the actuating finger 74 is displaced back while retaining finger 93 makes sure the products 48A, 48B and 48C hold their position in relation to the storage and retrieval device. With reference to Figure 9, the actuating finger 74 pulls back the product support 42 together with boxes 48A and 48B while the retaining finger 93 is in an upper position. Box 48C is the only box that remains on the storage and retrieval device. With reference to Figure 10, the actuating finger 74 moves in a righthand position and pivots into the clearance of the branch 63 so that the actuating finger 74

gets in contact with the box 48 by moving to a lefthand position as shown in Figure 11. None of the art of record discloses these patentable features.

Duncan et al. discloses a materials handling system. On page 4 of the Official Action, the Examiner concedes that *Duncan et al.* does not disclose V-shaped supports, the specific drive, pulling and retaining fingers. The Examiner seeks to rely on German Publication 4343631 for disclosing the use of V-shaped supports, *Tokiwa* for disclosing the specific drive arrangement and Figure 11, *Castaldi* for disclosing pulling fingers in Figure 5, and *Hoffmann* for disclosing the use of retaining fingers 120. The Examiner then alleges that it would have been obvious to a mechanic having ordinary skill in the art at the time the invention was made to provide these features to the primary reference. However, the Examiner has failed to establish *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. MPEP §2142.

The Federal Circuit has stressed that “our case law makes clear that the best defense against a subtle but powerful attraction of hindsight-base obviousness analysis as vigorous application of requirement for showing of the teaching or motivation to combine prior art references”. *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (Emphasis added). The Federal Circuit requires that the showing be “clear and particular.” *Id.* See, e.g., *C.R. Bard Inc. v. M3 Systems Inc.*, 48 U.S.P.Q.

2d 1225, 1232 (Fed. Cir. 1998). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'". *Id.*

This is precisely the case in the present matter. The Examiner has failed to point to specific information in any of the references which suggest the combination between the references in the manner suggested by the Examiner. The Examiner points to no factual basis for combining the references. The Examiner only make a broad conclusory statement that "it would have been obvious to a mechanic with ordinary skill in the art at the time the invention was made to provide these features to the primary reference." The Examiner also alleges that the other features are merely substitution of equivalents yet provides no basis for this argument. As such, the Examiner failed to make any "particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art reference", as specifically required by the Federal Circuit.

It is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching or motivation the prior art to do so. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837F.2d 1044, 1051-52, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988).

Applicant submits that there is no motivation in the art to combine the references with the primary reference of *Duncan et al.* In particular, German Publication 4343631, the compartments as shown in Figures 2 and 3 of the German Publication are not slidable along the respective shelves. Also, the compartments 32 do not have at least one face side open. As such, it is not possible to separate a single box out of the compartment 32 as is the case in the presently claimed shelf storage facility. In addition, *Duncan* discloses a material handling system which

handles articles in the shape of long rolls or boxes at predetermined bin areas. There are no means for separating different boxes being stored in one of the same bin areas, as is the case of the present invention. With regard to the remaining references, none of these references deal with the problem of separating single boxes from a storage device. As such, Applicant submits that one having ordinary skill in the art would not combine the references as suggested by the Examiner.

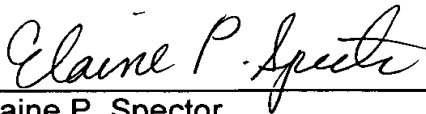
For at least the foregoing reasons, it is submitted that the shelf-storage facility of independent Claim 1, and the claims depending therefrom, is patentably distinguishable over the applied documents. Accordingly, withdrawal of the rejections of record and allowance of the application are earnestly solicited.

Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.

Respectfully submitted,

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